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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,031	01/28/2002	Naoya Watanabe	00862.022496	2187

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EXAMINER

NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,031

Applicant(s)

WATANABE, NAOYA

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date May 7, 2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-14 rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen U.S. Patent 5,864,684.
2. Regarding claims 1, 7, and 13, Neilsen discloses communication partner information storage means for storing communication partner information (e.g. information about subscribers) having predetermined registration items (e.g. distribution list which contain e-mail addresses) (col. 8 lines 17-19); identifier detecting means for detecting a predetermined identifier (e.g. commands such as suspend, add, remove, modify) from received e-mail (Figure 7; and col. 9 lines 9-23); and registering means for registering information described in the e-mail in accordance with the detected identifier (e.g. add command) into that registration item of the communication partner information which corresponds to the identifier (e.g. if listserver receive adds command it then automatically register the subscriber to the distribution list) (Figures 7 and 11B; col. 16 lines 13-22; and claim 15).
3. Regarding claims 2 and 8, Neilsen further discloses identifier determining means for determining whether the identifier (figure 7 suspend, add, remove, modify commands) is valid, wherein if the identifier is found to be invalid, said registering means does not register

Art Unit: 2143

information described in the e-mail in accordance with the identifier (Figure 4a [405]; col. 10 lines 5-11).

4. Regarding claims 3 and 9, Neilsen further discloses registration designating means by which a user designates registration by said registering means, wherein said registering means registers only information whose registration is designated by said registration designating means (col. 16 lines 13-22).

5. Regarding claims 4 and 10, Neilsen further discloses extracting means for extracting the communication partner information stored in said communication partner information storage means and mail generating means for generating e-mail data having a body in which pieces of information constituting the extracted communication partner information are described in one-to-one correspondence with identifiers corresponding the registration items in which these pieces of information are registered (col. 10 lines 31-40).

6. Regarding claims 5 and 11, Neilsen further discloses the information described in the e-mail in accordance with the detected identifier is described subsequently to the detected identifier (Figure 2b, such as information described in the subject field).

7. Regarding claims 6 and 12, Neilsen further discloses the registration items include at least two of the name, name reading, telephone number, and e-mail address of a communication partner (e.g. add command with contain the distribution list and email address of a subscriber) (Figures 2b and 7).

8. Regarding claim 14, Neilsen further discloses storage medium storing the control program of a communication apparatus according to claim 13 (Figure 1b [167]).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Funk et al. U.S. Patent 5,937,162

Nestoriak, III et al. U.S. Patent 6,353,852

Sommerer U.S. Patent 6,701,348

Waites U.S. Patent 6,788,769

Smith et al. U.S. Patent 6,282,564

Wood et al. U.S. Pub. 2002/0112007

Miloslavsky et al. U.S. Pub. 2002/0169834

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919.

The examiner can normally be reached on Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen
Examiner
Art Unit 2143

April 27, 2005



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100